

REMARKS

This is a full and timely response to the non-final Official Action mailed November 13, 2003. Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

By the forgoing amendment, claims 1, 8 and 29 have been amended, and claims 4 and 16-19 have been cancelled. Additionally, new claims 32-36 have been added. Claims 20-26 have been withdrawn from consideration. Thus, claims 1-3, 5-15 and 27-36 are currently pending for the Examiner's consideration.

With regard to the prior art, the recent Office Action rejected claims 1 and 3-6 as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 5,589,719 to Fiset ("Fiset"); claims 2, 8-14, 16-19 and 27-30 are rejected as unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Fiset and U.S. Patent No. 5,650,974 to Yoshimura ("Yoshimura"); and claims 7,15 and 31 are rejected under 35 U.S.C. § 103(a) over Fiset taken alone. For at least the following reasons, these rejections are respectfully traversed.

Claim 1 recites:

A smart card comprising:
processing and memory circuitry;
an interface for electrically connecting said smart card to a host device, said interface comprising a power line for receiving power from said host device;
a primary battery disposed in said smart card for providing power to said processing and memory circuitry; and
a secondary rechargeable battery disposed in said smart card for providing power to said processing and memory circuitry; and
recharging circuitry for recharging said secondary battery with power from said host device; and

means for preventing said primary and secondary batteries from charging each other.
(emphasis added).

In contrast, Fiset fails to teach or suggest the claimed “means for preventing said primary and secondary batteries from charging each other.”

On this point, the Office Action cites to Fiset at col. 6, lines 20-45 *et seq.* According to the Office Action, diodes D3 and D4, as taught by Fiset in col. 6, prevent discharge of the secondary battery into the primary battery and vice versa. This is a clear misreading of what Fiset actually teaches.

According to Fiset, “D3 does not allow current to pass back to the intermediate power supply circuit when the batteries are providing current.” (Col. 6, line 41). Similarly, “D4 does not allow current to pass from the battery to the intermediate power supply.” (Col. 6, line 47).

Thus, the diodes (D3 and D4) and other circuitry taught by Fiset prevent the batteries from passing current to the intermediate power supply (i.e., the recharging circuitry). Fiset does not teach or suggest anything about preventing primary and secondary batteries from charging each other as recited in claim 1. Moreover, Fiset does not teach or suggest diodes that prevent the batteries from charging each other as recited in claims 5 and 6. The Office Action has failed to identify any portion of the cited prior art that actually teaches the subject matter of claim 1.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, because Fiset fails to

teach or suggest the claimed means for preventing the primary and secondary batteries from charging each other, the rejection of claims 1-3 and 5-7 based on Fiset should be reconsidered and withdrawn.

Claim 8 recites:

A method of providing power to processing and memory circuitry of a smart card said method comprising:

providing a charged primary battery and a charged secondary battery in said smart card prior to installation of said smart card in a host device;

determining whether said primary or secondary battery has a higher voltage prior to installation of said smart card in said host device; and

providing power to said processing and memory circuitry with whichever battery has said higher voltage prior to installation of said smart card in said host device.

Support for the amendments to claim 8 can be found in Applicant's specification as originally filed at paragraphs 57-61.

In contrast, the cited prior art, including Fiset and Yoshimura, fails to teach or suggest a method including the steps of (1) providing a charged primary battery and a charged secondary battery in said smart card prior to installation of said smart card in a host device; (2) determining whether said primary or secondary battery has a higher voltage prior to installation of said smart card in said host device; and (3) providing power to said processing and memory circuitry with whichever battery has said higher voltage prior to installation of said smart card in said host device.

Thus, the cited prior art fails to teach or suggest all the features of claim 8.

Consequently, the rejection of claim 8 based on Fiset and Yoshimura should be reconsidered and withdrawn. For the same reasons, claims 9-15 and new claims 32-26, which all depend from claim 8, should be allowable over the prior art of record.

Claim 27 recites:

A method of providing power to processing and memory circuitry of a smart card said method comprising:

providing power to said processing and memory circuitry with a primary non-rechargeable battery disposed in said smart card prior to installation of said smart card in a host device;

charging a secondary rechargeable battery with power from said host device when said smart card is installed in said host device; and

providing power to said processing and memory circuitry with said secondary battery when said primary battery is depleted and said smart card is removed from said host device.

(emphasis added).

In contrast, Fiset fails to teach or suggest a method including “providing power to said processing and memory circuitry with a primary non-rechargeable battery disposed in said smart card prior to installation of said smart card in a host device.” (emphasis added). To the contrary, Fiset teaches that the both batteries are prevented from discharging and providing any power until after the card is installed in a host device. According to Fiset, “[b]ipolar transistors Q200, Q201, Q202 and resistors R8, R9, R11 comprise a circuit which keeps the batteries from discharging prior to host initial power up.” (Col. 6, lines 20-22).

Consequently, Fiset not only fails to teach or suggest all the elements of method claim 8, Fiset actually teaches away from the method of claim 8 by stating that the batteries are kept from discharging prior to installation in, and initial power up of, a host device. For at least this reason, the rejection based on Fiset of claims 27-31 should be reconsidered and withdrawn.

Claim 7 recites “access control data for a cable television system stored in said processing and memory circuitry.” Similar subject matter is recited in claims 15 and 31.

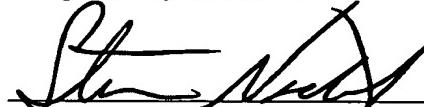
The Office Action acknowledges that Fiset fails to teach or suggest a smart card as claimed including "access control data for a cable television system stored" on the card. However, despite this shortcoming of the Fiset reference, the Office Action alleges that the provision of access control data for a cable television system in a claimed smart card would be an "engineering design choice." (Office Action, p. 5). This is legally insufficient to support a rejection of claim 7.

The examiner has the initial burden of demonstrating that all the claimed features of the invention are taught by the prior art. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Where the examiner relies on a single reference under § 103, it is insufficient to merely state that it would be obvious, or a mere matter of design choice, to modify the disclosure to include the features of the claimed invention. *In re Mills*, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. (emphasis added). Accord. M.P.E.P. § 706.02(j). The Board of Patent Appeals and Interferences refuses to uphold rejections in which the examiner simply alleges that the relevant feature of a claimed invention is a mere "design choice." Such a statement, in the words of the Board, "is a conclusion, rather than a reason." *Ex parte Garrett*, 1986 Pat. App. LEXIS 8, 4 (BPAI 1986).

The prior art as presently cited fails to teach or suggest all the features of claims 7, 15 and 31. For at least this reason, the rejection of claims 7, 15 and 31 based on Fiset should be reconsidered and withdrawn.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If any fees are owed in connection with this paper, which have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013/80113-0230 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,



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